

**Remarks**

This Application has been carefully reviewed in light of the Office Action mailed November 14, 2007 (the "Nov. 14, 2007 Office Action"). At the time of the Nov. 14, 2007 Office Action, Claims 37 and 40 were pending in the Application. Applicant respectfully requests reconsideration and favorable action in this case.

**Section 135 Rejections**

The Office Action rejects Claims 37 and 40 under 35 U.S.C. § 135(b)(1) as not being made prior to one year from the date on which U.S. Patent No. 5,988,598 (the "'598 patent") was granted. For at least the reasons discussed below Applicant respectfully traverses this rejection.

35 U.S.C. § 135(b)(1), related to interferences, states that:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Applicant respectfully submits that it has complied with these requirements. The Nov. 14, 2007 Office Action contends that "the original claims as filed and the amendments to the claims filed prior to Nov 23, 2000 in the history of the prosecution of the present invention failed to include the same or substantially the same invention of the US Patent No. 5,988,598." Nov. 14, 2007 Office Action, page 2. More specifically, the Nov. 14, 2007 Office Action contends that:

None of the original claims and the subsequent amended claims filed prior to Nov 23, 2000 includes the subject matter regarding a fastener, having two connectors, that connects the upper post member and a mid-connecting member, wherein (1) the fastener is weaker than a fastener that connects the mid-connecting member to a lower post member and (2) each of the two connectors of the fastener has different failure strength from one another."

Nov. 14, 2007 Office Action, pages 2-3.

Applicant respectfully disagrees. On June 9, 2000 Applicant submitted a response adding new Claims 37 and 38. *See* Response to Office Action filed June 9, 2000, page 2 (attached hereto as Exhibit A). The language of these Claims 37 and 38 as filed on June 9, 2000 corresponds word-for-word with the language of Claims 1 and 2, respectively, of the '598

patent. Thus, as of June 9, 2000 (a date that is within one year of the issuance of the '598 patent), the present application claimed the same or substantially the same invention as that of the '598 patent. As discussed below, Applicant made subsequent amendments to these claims. However, at all time since the June 9, 2000 addition of Claims 37 and 38, the application claimed the same or substantially the same invention as that of the '598 patent.

In an Office Action mailed November 24, 2000, the Examiner rejected Claims 37-38 under 35 U.S.C. § 112, first paragraph, because the Examiner contended that the original disclosure "does not include a second fastener for connecting the joint member to the lower post member." Nov. 24, 2000 Office Action, page 2. On March 29, 2001, after a telephonic interview with Examiner Kim, Claim 37 was amended to replace the term "a second fastener" with "an attachment" to overcome the § 112 rejection. *See* Response to Office Action filed March 29, 2001, pages 10 and 22. "Applicant agreed to this change with the understanding that Claim 37 would be considered to be in compliance with §112 while still corresponding substantially to the patent with which an interference is requested." *See* Response to Office Action, filed Nov. 6, 2002, page 2. Applicant notes that the Board of Patent Appeals and Interferences held in a March 23, 2007 decision that the specification as filed supported both the claim terms "second fastener" (recited in Claim 40 on the appeal) and "attachment" (recited in Claim 37 on the appeal).

In an Office Action mailed June 14, 2001, the Examiner rejected Claims 37 and 38 under 35 U.S.C. § 112, second paragraph, for lack of antecedent basis for the terms connecting joint "member" and upper post "member." June 14, 2001 Office Action, page 2. On July 17, 2001 Applicant amended Claim 37 to recite "said first end of said joint member" and Claim 38 to recite "said upper post member" in order to overcome the rejection. *See* Response to Office Action filed July 17, 2001, page 10. On December 7, 2001 Applicant amended Claim 37 to include the elements of Claim 38, and Applicant canceled Claim 38.

On April 24, 2003 Applicant added Claim 40. *See* Response to Office Action filed April 24, 2003, page 23. The language of Claim 40 corresponds to the language of Claims 1 and 2 of the '598 patent and also includes the term "member" as discussed above with respect to the July 17, 2001 amendment to Claims 37 and 38. Similarly, Claim 40 corresponds to the

language of Claims 37 and 38 as added June 9, 2000, within one year of the issuance of the '598 patent, and also includes the term "member" as added on July 17, 2001 in response to the Examiner's § 112 rejections. In addition, as noted above, the Board of Patent Appeals and Interferences found that the specification as originally filed provided support for both Claims 37 and 40. *See Board of Patent Appeals and Interferences Decision on Appeal Decided March 23, 2007, pages 3-4*

To summarize, Claims 37 and 38, as originally filed on June 9, 2000, were word-for-word copies of Claims 1 and 2 of the '598 patent. Claims 37 and 38 were filed prior to November 23, 2000 (the one year date from the issuance of the '598 patent) and included subject matter that is the same or substantially the same as the invention described in the '598 patent. During prosecution Applicant amended Claim 37 to recite "attachment" to overcome a § 112 rejection that was later found to be improper by the Board of Patent Appeals and Interferences and amended Claims 37 and 38 to overcome a § 112 rejection for antecedent basis issues raised by the Examiner. Applicant also amended Claim 37 to recite the elements of Claim 38. Thus, the only amendments to Claim 37 changing the language of the claim were made in response to § 112 issues raised by the Examiner, one of which was found to be improper. At all times since the addition of Claims 37 and 38 on June 9, 2000, did Claim 37 include subject matter that is the same or substantially the same as the invention described in the '598 patent. Moreover, Claim 40 corresponds to Claims 37 and 38 as filed on June 9, 2000 with the additional amendment to recite "member" to overcome the § 112 antecedent basis issue raised by the Examiner.

Therefore, it is clear that the claims in existence within one year of the issuance of the '598 patent included claims which were the same as, or for the same or substantially the same subject matter as, claims of the '598 patent. Claims 37 and 40 are claims that are the same as, or for the same or substantially the same subject matter as, those claims already in the application within one year of the issuance of the '598 patent. Any subsequent amendments were made to overcome § 112 issues raised by the Examiner.

Therefore, for at least this reason Applicant respectfully submits that the application is in compliance with 35 U.S.C. § 135(b)(1) and request that the rejections of Claims 37 and 40 be withdrawn.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTT S L.L.P.  
Attorneys for Applicant



Timothy R. Gerlach  
Reg. No. 57,548

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CORRESPONDENCE ADDRESS:

at Customer No. **05073**

Enclosure – Exhibit A – Response to Office Action filed June 9, 2000